

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 34

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**MAILED**

**SEP 30 2002**

Ex parte CHARLES KORMANIK JR.

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Appeal No. 2001-2537  
Application No. 08/802,472

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ON BRIEF

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Before STAAB, McQUADE, and CRAWFORD, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5, 8 to 15 and 17 to 31. Claims 1 to 4 have been withdrawn from consideration. Claims 6, 7 and 16 have been canceled.

The appellant's invention relates to a method for making thematic packaging (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Agapiou	4,815,607	Mar. 28, 1989
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The rejections

Claim 5 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Agapiou.

Claims 8 to 15 and 17 to 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Agapiou.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 30) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 29) and reply brief (Paper No. 32) for the appellant's arguments thereagainst.

Opinion

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claim 5 under 35 U.S.C. § 102(b) as being anticipated by Agapiou. To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 5 is directed to a method of making the combination of a thematic package and an article contained within the package. Claim 5 includes, *inter alia*, the step of constructing the package "as a replica of a recognizable icon." Claim 5 calls for the package to have "a shape that is different than a shape of the article contained therein." In addition, claim 5 sets forth that the shape of the package "visually convey[s] information about an activity associated with the icon in which the article is used." Reading claim 5 on one of appellant's disclosed embodiments, the package may be in the shape of a replica of a golf ball, and an article contained therein may be a golf tee. In this case, an activity "associated with" the golf ball replica

package would be playing the game of golf, and the article contained within the package, namely, a golf tee, is used in playing the game of golf.

Agapiou pertains to an educational kit for increasing safety awareness. The kit includes a container in the shape of a flat tire and at least one toy figure preferably in the form of an animal (e.g., a squirrel) having a flattened portion 44 and simulated tire tread 48 attached to the flattened portion.

We do not share the examiner's view that Agapiou anticipates claim 1. As stated by Agapiou at column 1, lines 50-55:

The kit of the present invention is believed to be particularly useful in educating young children. By placing a toy figure with the tire tread on its back under or in close proximity to the tire, a lasting visual impression of the hazards of pedestrian carelessness can be imparted to the child.

Hence, in Agapiou the disclosed activity in which the article contained with the package is used is to teach, generally, about safety awareness, and more particularly, about the hazards of pedestrian carelessness. While we appreciate the examiner's position to the effect that all shapes visually convey information about an activity associated with the package, the examiner has not persuaded us that an artisan would associate

educating pedestrians about safety awareness with Agapiou's container in the shape of a flat tire.

In view of the foregoing, we will not sustain the examiner's rejection of claim 5 under 35 U.S.C. § 102(b).

We turn next to the examiner's rejection of claims 8 to 15 and 17 to 31 under 35 U.S.C. § 103 as being unpatentable over Agapiou. Recognizing that Agapiou does not disclose, for example, that the package thereof may take the form of any of the various replicas recited in claims 8 to 15 and 24 to 26, the examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Agapiou reference by having the package resemble a particular ball . . . since a person of ordinary skill in the art at the time of the invention would provide a package with an article inside to resemble objects useful to the target consumer(s) who would purchase these items. It is notoriously well known to place rain gear or any other article, for that matter, inside a package. Further it is also well known to construct the package to resemble a familiar symbol to the target consumer.  
[answer at page 4]

We do not agree. In our view, Agapiou does not disclose or suggest any of the shapes for the package called for in claims 8 to 15, 24 to 26 and 31. On this basis alone, the § 103 rejection of these claims based on Agapiou cannot be sustained. As to the

remaining claims, namely claims 17 to 23 and 27-30, these claims all depend either directly or indirectly from claim 5.<sup>1</sup> In that the examiner has not established a *prima facie* case of anticipation or obviousness of base claim 5, the § 103 of these claims also cannot be sustained.

The decision of the examiner is reversed.

Remand to the examiner

In addition to the foregoing, we find it necessary to remand this case to the examiner to consider whether any of claims 5, 8 to 15 and 17 to 31 would have been obvious in view of the following patents: Des 388,606; Des 392,096; Des 394,156; Des 373,245; US D449,711 S; Des 431,879; Des 424,295; Des 217,412; Des 194,287; US D449,777 S; Des. 346,185; Des. 57,436; Des 262,189; Des. 390,103 (copies attached).

For example, Des. 394,156 discloses a tire shaped emergency road kit. The shape of the package is a replica of a tire and the tire shape may be considered to visually convey information about an "associated" activity, such as changing a tire. The examiner should consider whether Des. 384,156 would have

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<sup>1</sup>Claims 27-30 are multiple dependent claims that depend from any one of claims 5 and 8 to 23.

suggested to a person of ordinary skill in the art to include articles such as a lug wrench, car jack etc. in the emergency road kit.

Further, for example, Des. 424,295 discloses a tool case package which is a replica of a wrench. The wrench shape may be considered to visually convey information about an "associated" activity such as using tools to maintain or repair various items. The examiner should consider whether Des. 424,295 would have suggested to a person of ordinary skill in the art to include, for example, a hammer, screw driver etc. which have a shape different from the wrench shape.

Des. 262,189 discloses a container for first aid items or the like which is shaped like a band aid. The band aid shape may be considered to visually convey information about an "associated" activity such as giving first aid treatment. The shape of the gauze, adhesive tape and circular bandages are different from the shape of the band aid shaped container. The examiner should consider whether it would have been obvious to store, for example, gauze, adhesive tape, circular bandages etc. within the band aid shaped container.

In addition, the examiner should consider whether some or all of the claims would have been rendered obvious in view of the





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